

Attorney Docket: 112.P14189

**REMARKS**

Claims 1-2, 4-5, 9-11, and 14-18 are pending in the above-referenced patent application. In this response, claims 1, 4, 9 and 14 have been amended, and no claims have been added or cancelled.

**Allowable Subject Matter**

The Examiner has objected to claims 4-5, 10-11 and 17-18 as being dependent on a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form. Assignee would like to thank the Examiner for finding allowable subject matter. In response to this offer to allow claims 4-5, 10-11 and 17-18, assignee has additionally amended claims 1, 4, 9 and 14 to include limitations found in some of the claims 4-5, 10-11 and 17-18. It is believed that these amendments place claims 1-2, 4-5, 9-11, and 14-18 in a condition for allowance, and obviate the rejections to the claims, as noted below. Therefore, it is respectfully requested that the Examiner enter these amendments, so that these claims may proceed to allowance.

**35 U.S.C 102(b)**

In the Final Office Action, dated March 24, 2006, the Examiner rejected claims 1-2, 9, 14 and 15 under 35 U.S.C 102(b) as being anticipated by "Applicant's Admitted Prior-Art", hereinafter "AAPA". This rejection is respectfully traversed.

Although Assignee does not agree with the Examiner's characterization of what applicant has admitted as prior art, Assignee respectfully submits that AAPA does not set forth each and every element of the rejected claims, as amended, and, therefore, contrary to the Examiner's assertion, the claims are not anticipated by AAPA under 35 U.S.C. 102(b). As just an example, referring to claim 1, as amended, AAPA does not set forth at least "a shell, having an upper and lower surface, wherein a groove is formed on the upper surface, and wherein at least one hole adapted to receive a fixing mechanism is formed in the groove; and a fixing mechanism disposed in the at least one hole, wherein the fixing mechanism is adapted to fix one of a document window glass and/or a transmission document carrier to the groove." (emphasis supplied). Furthermore, in the Background section of the present patent application, there is described a flat bed scanner having an open groove arranged at a

Attorney Docket: 112.P14189

side surface, NOT the upper surface as claimed and as asserted by the Examiner, wherein the open groove is formed to receive a transmission document carrier. This is clear from the text of the specification in which FIG. 2 is discussed at paragraph [0005], lines 10-12:

Please refer to FIG. 2, wherein an open groove 111 is arranged at one side surface with transmission document carrier 16. (emphasis added)

Thus, with all due respect, the Examiner's characterization of the AAPA is simply incorrect. The AAPA simply does not disclose that "a groove is formed on the upper surface" as recited in claim 1 because clearly the AAPA only discloses that the groove is arranged at one side surface.

It is therefore respectfully submitted that because AAPA does not set forth each and every element of claim 1, as amended, contrary to the Examiner's assertion AAPA does not anticipate claim 1 under 35 U.S.C. 102(b), and claim 1 is in a condition for allowance. Likewise, claims 2, 9, 14 and 15, as amended, are in a condition for allowance for at least the same reasons as those presented with respect to claim 1, as amended. It is noted that many other bases for traversing the rejection could be provided, but Assignee believes that this ground is sufficient. It is, therefore, respectfully requested that the Examiner withdraw this rejection of claims 1, 2, 9, 14 and 15.

#### **Claim Rejections – 35 U.S.C 103(a) – AAPA**

##### **1. Failure to teach all the claim limitations**

In the Final Office Action, dated March 24, 2006, the Examiner rejected claim 16 under 35 U.S.C 103(a) as being unpatentable over AAPA. This rejection is respectfully traversed.

Although Assignee does not agree with the Examiner's characterization of AAPA, it is respectfully submitted that AAPA does not teach or suggest all of the elements of claim 16, either expressly or inherently, and, therefore, a *prima facie* showing of obviousness has not been established.

It is noted that in order to establish *prima facie* obviousness, there must be some suggestion or motivation to modify or combine reference teachings, and the modification or combination, if

Attorney Docket: 112.P14189

successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that AAPA does not meet these criteria. For example, AAPA, even if successfully modified, does not teach or suggest all of the elements of claim 16, either expressly or inherently. Therefore, claim 16 is not rendered obvious by AAPA.

As just an example, AAPA does not teach or suggest "forming a shell having an upper and lower surface; forming a groove on the upper surface of the shell; forming a hole in the groove; and disposing a fixing mechanism in the hole" (emphasis supplied), as recited in claim 14, from which claim 16 depends. As stated previously, AAPA describes a flat bed scanner having an open groove arranged at a side surface, wherein the open groove is formed to receive a transmission document carrier, but does not teach or suggest all at least the limitations noted above, either expressly or inherently.

Assignee respectfully submits that because a *prima facie* case of obviousness has not been established, claim 16 is in a condition for allowance. It is noted that many other bases for traversing the rejection could be provided, but Assignee believes that this ground is sufficient. It is, therefore, respectfully requested that the Examiner withdraw this rejection to claim 16, and allow all pending claims to proceed to allowance.

Attorney Docket: 112.P14189


**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, she is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Dated: 5/24/06

Respectfully submitted,

  
\_\_\_\_\_  
Michael J. Willardson  
Patent Attorney  
Reg. No. 50,856

Customer No. 43831  
Berkeley Law and Technology Group, LLC  
1700 NW 167th Place, Suite 240  
Beaverton, OR 97006  
503-439-6500

**CERTIFICATE OF FACSIMILE TRANSMISSION**

*I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office on:*

May 24, 2006

*Date of Transmission*

Ilka Dalton

*Name of Person Transmitting Correspondence*

  
\_\_\_\_\_  
*Signature*